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09/583,216	05/30/2000	Lou Leonardo	003801.P021	2363

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Sang Hui Michael Kim  
Blakely Sokoloff Taylor & Zafman LLP  
12400 Wilshire Boulevard Seventh Floor  
Los Angeles, CA 90025

EXAMINER
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FRENEL, VANEL

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 10/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/583,216

Applicant(s)

LEONARDO ET AL.

Examiner

Vanel Frenel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2000.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

**DETAILED ACTION**

***Notice to Applicant***

1. This communication is in response to the Amendment filed on 07/17/03. Claims 1-20 are pending.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al (5,835,896) in view of Campbell (US 2001/0041993).

(A) As per claim 1, Fisher discloses a method for a network-based facility (Col.1, lines 6-39; Col.2, lines 35-58), the method comprising:

facilitating a submission of a complaint to the network-based

facility, the complaint relating to a network-based transaction (Col.1, lines 40-67;

Col.2, lines 10-67);

associating an identifier to the complaint (Col.6, lines 46-67);

facilitating a resolution of the complaint associated with the identifier (Col.7, lines 50-65). Fisher does not explicitly disclose facilitating a claim for insurance if the complaint is not resolved.

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However, this feature is known in the art, as evidenced by Campbell. In particular, Campbell suggests a claim for insurance if the complaint is not resolved (See Campbell, Page 5, Paragraph 0048).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Campbell within the system of Fisher with the motivation of empowering the claimant's attorney to resolve a claim much faster than under the current system, thereby allowing the attorney to collect legal fees much more quickly. By resolving claims faster, attorneys can handle more cases and generate more income and better server their clients, the claimants (See Campbell, Page 1, Paragraph 0006)

(B) As per claim 2, Fisher discloses the method wherein the network-based facility is a network-based online auction facility and the network-based transaction is a network-based online auction transaction (Col.2, lines 35-59).

(C) As per claim 3, Fisher discloses the method wherein the facilitating of the submission of the complaint includes: providing an interface for a user to input information for the complaint (Col.7, lines 35-67).

(D) As per claim 4, Fisher discloses the method wherein the providing of the interface includes: providing an interface for a bidder or an interface for a seller selected by the user (Col.7, lines 7-65).

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(E) As per claim 5, Fisher discloses the method wherein the facilitating of the resolution includes: providing a status interface for a user to view a current status or provide comments related to the complaint associated with the identifier or an interface to report a status of the complaint associated with the identifier (Col.8, lines 42-67).

(F) As per claim 6, Fisher discloses the method wherein the providing of the status interface includes: providing an interface for a user who is complained against to input comments related to the complaint associated with the identifier (Col.6, lines 46-67);

(G) As per claim 7, Campbell discloses the method wherein the facilitating of the claim for insurance includes: providing an interface for a user to file an insurance claim if the complaint has not be resolved after a certain period of time (Page1, Paragraph 0006).

(H) As per claim 8, Campbell discloses the method wherein the facilitating of the resolution includes: providing an interface allowing a user who is complained against to respond to the complaint (Page 4, Paragraph 0037-0038).

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(I) As per claim 9, Campbell discloses the method wherein the facilitating of the resolution includes: exchanging comments between a complaining user and a complained against user regarding the complaint associated with the identifier (Page 4, Paragraph 0039).

(J) As per claim 10, Fisher discloses a network-based facility system, comprising: a database configured to maintain records of network-based transactions (Col.2, lines 35-67; Col.6, lines 13-67); and

a processing unit configured to facilitate a submission of a complaint from a user, the complaint relating to a network-based transaction record maintained by the database, to associate an identifier to the complaint (Col.7, lines 8-65), to facilitate a resolution of the complaint associated with the identifier (Col.5, lines 50-65). Fisher does not explicitly disclose facilitate a claim for insurance if the complaint is not resolved.

However, this feature is known in the art, as evidenced by Campbell. In particular, Campbell suggests a claim for insurance if the complaint is not resolved (See Campbell, Page 5, Paragraph 0048).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Campbell within the system of Fisher with the motivation of empowering the claimant's attorney to resolve a claim much faster than under the current system, thereby allowing the attorney to collect legal fees much more quickly. By resolving claims faster, attorneys can handle more cases and generate more

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income and better server their clients, the claimants (See Campbell, Page 1, Paragraph 0006)

(K) As per claim 11, Fisher discloses the network-based facility system wherein the network-based transaction record is a network-based online transaction record (Col.2, lines 35-59).

(L) As per claim 12, Fisher discloses the network-based facility system wherein the processing unit is further configured to provide an interface for a user to input information for the complaint (Col.7, lines 35-67).

(M) As per claim 13, Fisher discloses the network-based facility system wherein the processing unit is further configured to provide an interface for a bidder or an interface for a seller selected by the user (Col.7, lines 7-65).).

(N) As per claim 14, Fisher discloses the network-based facility system wherein the processing unit is further configured to provide a status interface for a user to view a current status and provide comments related to the complaint associated with the identifier or an interface to report a status of the complaint associated with the identifier (Col.7, lines 7-67).

(O) As per claim 15, Fisher discloses the network-based facility system wherein the

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processing unit is further configured to provide an interface for a user who is complained against to input comments related to the complaint associated with the identifier (Col.6, lines 46-67);

(P) As per claim 16, Campbell discloses the network-based facility system wherein the processing unit is further configured to provide an interface for a user to file an insurance claim if the complaint has not be resolved after a certain period of time (Page 1, Paragraph 0006; Page 5, Paragraph 0048).

(Q) As per claim 17, Campbell discloses the network-based facility system wherein the processing unit is further configured to provide an interface allowing a user who is complained against to respond to the complaint (Page 4, Paragraph 0037-0038).

(R) As per claim 18, Campbell discloses the network-based facility system wherein the processing unit is further configured to facilitate exchange of comments between a complaining user and a complained against user regarding the complaint associated with the identifier (Page 4, Paragraph 0039).

(S) Claim 19 differs from claims 1 and 10 by reciting a machine-readable medium that provides instructions, which when executed by a machine.

As per this limitation, Fisher discloses said machine to perform operations comprising:



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facilitating a submission of a complaint to the network-based facility, the complaint relating to a network-based transaction (Col.1, lines 40-67; Col.2, lines 10-67);

associating an identifier to the complaint (Col.6, lines 46-67); facilitating a resolution of the complaint associated with the identifier (Col.7, lines 50-65) and Campbell discloses facilitating a claim for insurance if the complaint is not resolved.

Thus, it is readily apparent these prior art systems utilize a machine-readable medium that provides instructions to perform the their specified function.

The remainder of claim 19 is rejected for the same reason given above for claims 1 and 10, and incorporated herein.

(T) As per claim 20, Fisher discloses the machine-readable medium wherein the network-based facility is a network-based online auction facility and the network-based transaction is a network-based online transaction (Col.2, lines 35-59).

### ***Response to Arguments***

4. Applicant's arguments filed on 07/17/03 with respect to claims 1-20 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed on 07/17/03.

(A) At pages 7-10, of the 07/17/03 response, Applicant's argues:

(1) Fisher and Campbell are not prior art and reserve the right to swear behind the references at a late date. Nonetheless, Applicants believe that the present invention

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is distinguishable over the combination of references because the combination does not disclose each and every element of the invention as claimed.

(2) Fisher does not teach or suggest "facilitating a resolution of the complaint associated with the identifier" and performing any actions based on a complaint.

(3) Fisher in view of Campbell does not render claim 1 obvious.

(B) With respect to Applicant's first argument, Examiner respectfully submits that obviousness is not determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977F. 2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1992); *In re Piaseckii*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (See paper number 7). Note, for example, in the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s) which specially support that particular motivation and /or an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness. As such, it is not seen that the Examiner's

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combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one of ordinary skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300(Bd. Pat. App.& Inter., 4/22/93). Therefore, the combination of references is proper and the rejection is maintained.

In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). Therefore, Applicant's argument is not persuasive.

(C) With respect to Applicant's second argument, Examiner respectfully suggests Campbell discloses "An attorney that wishes to "bid" on unresolved insurance claims must be registered on the legal server 102. The attorney, using the attorney computer 118, establishes communication with the legal server102 via the communication network 116using the network browser. Once the attorney establishes communication with the legal server102, the login module 312 presents the attorney with a login

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display. If the attorney has previously registered, the attorney can log onto the legal server 102 and participate in the claim auctioning process. If the attorney has not previously registered, the attorney registration module 310 prompts the attorney for registration information, confirms the attorney's identity, and approves the attorney's registration. Thereafter, the attorney is able to log onto the legal server 102 and participate in the claim auctioning process" which correspond to Applicant's claimed feature (See Campbell, Col.5, Paragraph 0046). Therefore, Applicant's argument is not persuasive.

(D) With respect to the third argument, Examiner respectfully suggests that Applicant merely provides a piecemeal analysis of the teachings of the Fisher and Campbell references, separately, and in a vacuum. As such, it is respectfully submitted that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, with specific reference to Applicant's remarks about the Fisher reference, the Examiner respectfully submits that it is sufficient to demonstrate that the prior art meets the limitations as claimed, whether by a single instance or scenario, or in every possible preferred embodiment, since it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and

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(iii) the question is not express teaching of references, but what they would suggest. Therefore, Applicant's argument is not persuasive.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not the applied art teaches method for electronic merchandise dispute resolution (6,336,095), method and apparatus for cryptographically assisted commercial network system designed to facilitate buyer-driven conditional purchase offers (5,794,207) and online method and system for fulfilling needs resulting from property and other similar losses (US 2002/0035528).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on 6:30am-5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

V.F

October 5, 2003

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(B) In response to Applicant's argument that the references fail to show certain features of Applicant's invention, it is noted that the features upon which Applicant relies (i.e., automatic or machine generation of treatment recommendations; or recommendations NOT based on treatment prescribed by a health care provider) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Further, it is respectfully submitted that Applicant merely provides a piecemeal analysis of the teachings of the Fisher and Campbell references, separately, and in a vacuum. As such, it is respectfully submitted that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, with specific reference to Applicant's remarks about the Fisher reference, the Examiner respectfully submits that it is sufficient to demonstrate that the prior art meets the limitations as claimed, whether by a single instance or scenario, or in every possible preferred embodiment, since it was determined in *In re Lamberti et al.*, 192-USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

In particular, Applicant clearly fails to properly consider non-preferred embodiments of Goodman (i.e., an embodiment that does not require a plan provided

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by a medical provider) and seems to require absolute predictability by the Goodman system to fully automated. It is respectfully submitted that Applicant's position is clearly improper based on the aforementioned case law.

Thus, the fact situations provided by the Examiner (e.g., automated generation on algorithms based solely on treatment parameters and not input by a medical provider – see col. 10, lines 29-36 of Goodman), no matter how “infrequent” or “occasional” they may be, are indeed embodiments that Applicant is expected to have considered. As such, since Applicant fails to expressly recite limitations that provide a patentable distinction over such fact situations, it is respectfully submitted that prior art reads on Applicant's claimed limitations. Therefore, Applicant's argument is not persuasive.

**5. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.



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**Conclusion**

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches method of improving drug treatment (6,000,828) and remote psychological diagnosis and monitoring system (6,334,778).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on 6:00am-5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

V.F

V.F

October 5, 2003

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600